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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,946	02/28/2000	Richard Fernandes	2470-105A	8679

6449 7590 07/14/2003

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WASHINGTON, DC 20005

EXAMINER

CARLSON, JEFFREY D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/514,946

Applicant(s)

FERNANDES, RICHARD

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-10 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10 and 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

1. This action is responsive to the paper(s) filed 4/28/03.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 3-10 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al in view of Roth et al (US6285987).**

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Gardenswartz et al discloses prior art systems that provide targeted banner ads to Internet web site visitors. Gardenswartz et al discloses Internet-connected users that collect cookies stored on their machines as they visit different web sites. When the user accesses a particular web site, a cookie (including userID) is uploaded to the web server [col 2 lines 11-19] so as to request customization of the web page. This uploading/reading inherently includes at least temporary storage of the cookie's information (sites visited, userID, activity) and is taken to provide consumer information storage. Because cookies are used to track online activity, the web server can deliver a targeted advertisement based on the users online activity. [col 2 lines 20-23]. "The web server can deliver ad banners to the consumer's web browser based on the IP addresses the web browser has accessed... Thus, the cookie can be used to record the online activity of a consumer" [col 2 lines 24-28]. The user's tastes and tendencies can be inferred from the activity and this can be used as a basis for the selection of the targeted ad [col 2 lines 28-33]. The stored preferences information can be taken to be the sites visited (user prefers those sites). Further, the inferred preferences [col 2 lines 28-33] used to target an ad inherently requires at least temporary storage of such preference information to carry out such targeting by the computer system described by Gardenswartz et al. Further, Gardenswartz et al suggests relying on Internet activity *including online purchases* as a basis for targeted advertising. Such purchases can also be taken to be "consumer preference information" contained in said activity information.

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Roth et al teaches a central server that is used to carry out targeted Internet advertising. Roth et al teaches tracking user's visits to particular web sites [col 1 lines 30-38] and using this information to provide targeted ads. The centralized system includes database storage of ads as well as storage of information regarding the subscribing sites [col 2 lines 1-5]. Depending on the customer visiting, the characteristics of the subscribing site and other information, an ad is selected to be displayed to the user [col 2 lines 20-41]. It would have been obvious to one of ordinary skill at the time of the invention to have implemented a centralized system as described by Roth et al so that targeted ads can be selectively sent to web site viewers of subscribing member web sites.

Regarding claim 1, it is inherent that the promotions of Gardenswartz et al and/or Roth et al are promoting either goods or services. Cookies are taught to be used to track sites visited (IP addresses) as well as online purchases, as explained above. The cookies are unique consumer identifiers, while the IP addresses are network site identifiers, both of which are stored to enable the ad database to deliver a targeted ad when the consumer visits a participating site that is to include such advertising.

Regarding the broad "subscriber" language of claims 1 and 22, the participating web site that displays the targeted advertising is taken to be a subscriber/subscriber site offering a targeted promotion. The website site subscribes to and is related to the central ad serving system which serves the advertising to the subscribing website.

Regarding claim 8, Gardenswartz et al teaches using cookies to track user's Internet browsing history. Gardenswartz et al also teaches tracking online purchases;

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this is taken to provide a history that includes association with such reviewed products (or services). Further, Gardenswartz et al also teaches to rely on the types on subject matter accessed/reviewed [col 2 lines 52-53], where the history of sites visited includes IP addresses corresponding to fly fishing for example.

Regarding claim 24, Gardenswartz et al and Roth et al do not limit the user's history to only pages visited or purchases made on sites where targeted advertising is provided by the system. It would have been obvious to one of ordinary skill at the time of the invention to have used any visited IP addresses or purchases made from any IP addresses as part of the history, including from sites that are "non-subscribers" or are not configured to receive the targeted advertising of the taught system(s). this would enable a wider range of visited sites to enrich the history profile, thereby enriching the targeted advertising.

**6. Claim 8 (alternatively) is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al in view of Travis et al (US2002/0010668).**

Travis et al teaches dynamically providing targeted ads to viewers of web sites. Travis et al teaches a database of user profiles/preferences that includes purchases made and products reviewed which is used during selection of a banner ad [para 21]. It would have been obvious to one of ordinary skill at the time of the invention to have used such stored preference information as products/services reviewed and products/services purchased to create a more accurate profile so that the system of Gardenswartz et al can deliver a more effective ad.

### ***Response to Arguments***

Applicant provides no additional claim language that specifies the meaning of "subscriber." The term "subscriber" can mean an entity who expresses a belief, such as a belief in online commerce or online advertising. "Subscriber" may also mean an entity who pays a fee for a good or service in return; applicant however does not provide any claim language to define "subscriber" as such an entity - there is no claim language specifying any entity paying fees, nor any services rendered for fees. No particular business relationship between advertisers, website and products offered in the promotions is required.

As stated above, with respect to the broad "subscriber" language of claims 1 and 22, the participating web site that displays the targeted advertising is taken to be a subscriber/subscriber site offering a targeted promotion. The website subscribes to and is related to the central ad serving system which serves the targeted advertising to the subscribing website.

Applicant argues that there is no motivation to combine the reference because Gardenswartz et al teaches using offline consumer profile information to target ads. While Gardenswartz et al does teach such, the reference discloses in the Background, using online activity of IP addresses visited and online purchases made to target ads. This is done using cookies and is based on passive consumer activity such as web surfing, in the same manner as the instant invention. One of ordinary skill would find it

obvious to combine the disclosure of targeting ads using online activity with the methods of Roth et al.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers



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for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc  
July 10, 2003